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25006	7590	06/01/2007	EXAMINER	
GIFFORD, KRASS, SPRINKLE, ANDERSON & CITKOWSKI, P.C.			KASZTEJNA, MATTHEW JOHN	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/827,493  
Filing Date: April 19, 2004  
Appellant(s): TEMPLE, JOHN

MAILED  
JUN 01 2007  
Group 3700

John G. Posa  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed February 1, 2007 appealing from the Office action mailed August 30, 2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

**NEW GROUND(S) OF REJECTION**

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan et al. (U.S. Patent No. 5,910,106) in view of Beane et al. (U.S. Patent Application Publication No. 2002/0022762).

### **WITHDRAWN REJECTIONS**

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner.

Claims 1, 2 and 4 as being rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan et al. (U.S. Patent No. 5,910,106) in view of Meckstroth (U.S. Patent No. 5,651,757).

Claim 3 as being rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan et al. (U.S. Patent No. 5,910, 106) in view of Meckstroth (U.S. Patent No. 5,652,757), and further in view of Beane et al. (U.S. Patent Application Publication No. 2002/0022762).

#### **(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

#### **(8) Evidence Relied Upon**

5,910,106	Morgan et al.	6-1999
2002/0022762	Beane et al.	2-2002

#### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,910,106 to Morgan et al.

**In regards to claim 1**, Morgan et al. disclose a system for warming an endoscope, laparoscope, or other such instrument to minimize fogging, comprising: a flexible pad 21 having a length, a width and a periphery for wrapping around the

instrument, the pad including a mixture of water and sodium acetate to generate heat through an exothermic reaction (see Col. 4, Lines 52-62), an activation disc 41 located around the periphery of the pad and one or more elongate partitions running lengthwise along the pad to establish fold line, each partition including a gap to facilitate fluid transfer of the mixture (see Figs 2-3).

**In regards to claim 2**, Morgan et al. disclose a system for warming an endoscope, wherein the activation disc 41 is made of perforated stainless steel (see Col. 5, Lines 5-35).

**In regards to claim 4**, Morgan et al. disclose a system for warming an endoscope, further including a heat-conductive tube to receive the instrument around which the pad is wrapped (see Figs. 2-3).

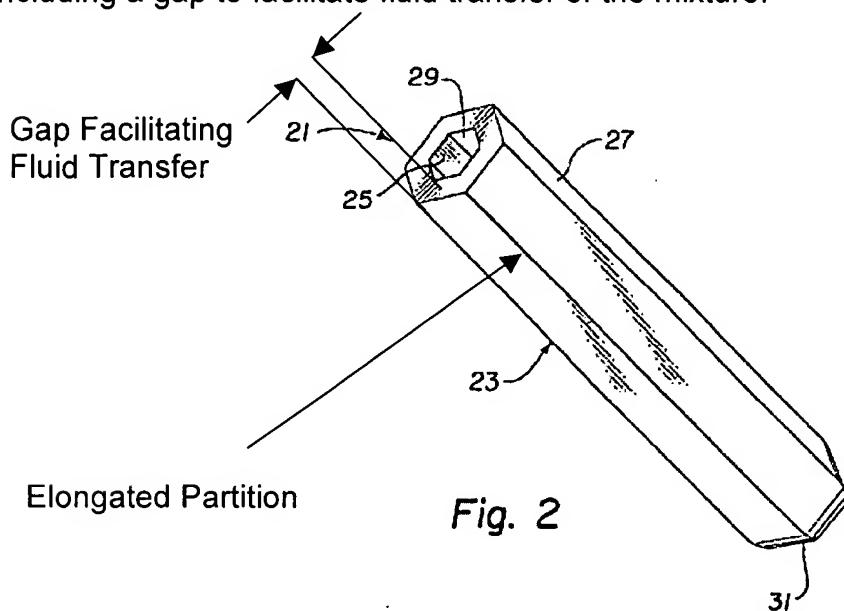
Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan et al. (U.S. Patent No. 5,910, 106) in view of Beane et al. (U.S. Patent Application Publication No. 2002/0022762).

**In regard to claim 3**, Morgan et al. are silent as to a housing to contain the sheath 23. However, Beane et al. disclose a similar warming device for an endoscope 10 where the device 110 has a housing 112 that contains a heating pad 120 into which the endoscope 10 is inserted (see Figure 2A). Beane et al. thus demonstrate that housing for containing a device to heat the insertion tube of an endoscope are well known in the art. Accordingly, it would have been obvious for one of ordinary skill in the art at the time the invention was made to provide the instrument heater 21 of Morgan et al. with a housing to contain the sheath 23.

**(10) Response to Argument**

Applicant states that Morgan et al. does not teach or suggest a flexible pad for wrapping around the instrument. As defined, a pad is a thin, cushionlike mass of soft material used to fill, to give shape, or to protect against jarring, scraping, or other injury (see <http://dictionary.reference.com/browse/pad>). Morgan et al. clearly discloses an apparatus 23 wrapped around a probe 3 constructed of a flexible and nonporous material, which is filled with a chemical solution, and thus can be interpreted as a pad (see Fig. 2 and Col. 4, Lines 45-51). Furthermore, it is desirable for the apparatus to protect against jarring so as to prevent damage to the endoscope contained therein. Thus, as broadly as claimed, Morgan et al. discloses a flexible pad for wrapping around an instrument.

Applicant states that Morgan et al. fails to disclose one or more elongated partitions running lengthwise along the pad to establish fold lines, each partition including a gap to facilitate fluid transfer of the mixture.



As seen in figure 2 above, elongated partitions are clearly seen running lengthwise along the pad and create a folded area. Furthermore, in the broadest interpretation of the claim, the gap is understood as being the space between the inner wall 25 and the outer wall 27. This gap clearly facilitates fluid transfer of the mixture as Morgan et al. teaches that the apparatus may be massaged to induce a faster reaction by mixing more metal nodules into the chemical solution throughout the length of the apparatus (see Col. 5, Lines 50-58). Thus as broadly as claimed, Morgan et al. meets the limitations of the recited claims.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). It would have been obvious for one of ordinary skill in the art at the time the invention was made to provide the instrument heater 21 of Morgan et al. with a housing to contain the sheath 23 to further protect the instrument from mechanical damage as taught by Beane et al.

#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte dismissal of the appeal* as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

  
Matthew Kasztejna

Art Unit 3739

5/17/7

**A Technology Center Director or designee must personally approve the  
new ground(s) of rejection set forth in section (9) above by signing below:**

  
MICHAEL R. SCHMIDT  
DIRECTOR  
TECHNOLOGY CENTER 3700

Conferees:



LINDA C. M. DVORAK  
SUPERVISORY PATENT EXAMINER  
GROUP 3700



ANGELA D. SYKES  
SUPERVISORY PATENT EXAMINER  
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